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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,655	03/17/2004	Takao Inoue	50024-025	1697

  

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EXAMINER	
WILLS, MONIQUE M	

ART UNIT	PAPER NUMBER
1745	

MAIL DATE	DELIVERY MODE
10/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/801,655	<b>Applicant(s)</b> INOUE ET AL.	
	<b>Examiner</b> Monique M. Wills	<b>Art Unit</b> 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/20/05 &amp; 3/17/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of claims 1-12 in the reply filed on 7/23/07 is acknowledged.

Claims 13-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method of making a positive electrode, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on July 23, 2007.

### *Claim Objections*

Claims 4 & 10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Requiring magnesium to be electrochemically substituted for part of the lithium in the oxide does not further limit the lithium-manganese-oxide material of the independent claims.

*Claim Rejections – 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 & 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Peled et al. U.S. Pat. 5,591,543.

With respect to claim 1, Peled teaches a non-aqueous electrolyte secondary battery comprising: a negative electrode, positive electrode and a non-aqueous electrolyte, wherein the cathode contains an oxide containing magnesium substituted for part of lithium. The limitation with respect to the rock-salt structure is considered an inherent property of the prior art set forth, because the Peled teaches the identical compounds set forth by applicant. In accordance with MPEP 2112.01, “ [p]roducts of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are

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necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). In the instant case, the rock-salt structure is necessarily present because the lithium compounds are the same.

With respect to claims 2, 3, 8 & 9, the cathode compound is  $\text{Li}_x\text{M}_{x/2}\text{CoO}_2$  where x is between 0.4 to 1 and M is magnesium. See the Abstract and col. 2, lines 29-40. With respect to claims 4,6,7 & 10, the magnesium electrochemically substitutes part of the lithium in the oxide. See the Abstract and col. 2, lines 29-40.

Therefore, the instant claims are anticipated by Peled.

### *Claim Rejections – 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 & 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peled et al. U.S. Pat. 5,591,543 in view of Loch et al. U.S. Pat. 6,171,723.

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Peled teaches an electrochemical cell as described in the rejection recited hereinabove. Peled teaches dimethyl carbonate and ethylene carbonate electrolyte solvents (col. 3, lines 45-55).

Peled does not teach a non-aqueous electrolyte including an imide salt.

However, Loch teaches that it is well known in the art to employ imide salts in ethylene carbonate and dimethyl carbonate electrolyte mixtures.

Peled and Loch are analogous art, because they are from the same field of endeavor namely, fabricating lithium secondary cells with carbonate electrolyte solvents. See Example 19.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ the imide salt of Loch, in the electrolyte of Peled, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the same intended purpose. In re Leshin, 125 USPQ 416.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number

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is (571) 272-1309. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Patrick Ryan, may be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MW

9/28/07

  
PATRICK JOSEPH RYAN  
SUPERVISORY PATENT EXAMINER